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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/018,064	10/30/2001	Andreas Arlt	12097	5772
28484 7590 08/29/2008 BASF AKTIENGESELLSCHAFT CARL-BOSCH STRASSE 38, 67056 LUDWIGSHAFEN LUDWIGSHAFEN, 69056 GERMANY				
EXAMINER				
COONEY, JOHN M				
ART UNIT		PAPER NUMBER		
1796				
NOTIFICATION DATE		DELIVERY MODE		
08/29/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

fernando.borrego@basf.com  
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## Office Action Summary

**Application No.**

10/018,064

**Applicant(s)**

ARLT ET AL.

**Examiner**

John Cooney

**Art Unit**

1796

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 4, 6, 9 and 10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 6, 9 and 10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8-19-08 has been entered.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1,4,6, 9, and 10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The new limitation to the at least one compound (i) of applicants' claims stating, "and wherein the unsaturated functionality of at least 0.1% by weight of compound (i) based on the weight of the polyurethane foam is either: 1) reacted with a primary and/or secondary amine formed from cleavage of a urethane and/or urea bond in the polyurethane foam, or 2) unreacted and available for reaction with a primary and/or

secondary amine formed from cleavage of a urethane and/or urea bond in the polyurethane foam", lacks support in applicants' originally filed supporting disclosure such that it is evident that applicants, at the time the application was filed, had possession of the claimed invention.

It is not seen that the new range of values pertaining to unsaturated functionality can be extrapolated from the range of values provided for by the claims in reference to compound (i.)

This is a new matter rejection.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1,4,6, 9, and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Smith (6,114,402).

Smith disclose the preparation of polyurethane foams useful in applications as set forth by applicants' claims prepared from isocyanates, polyols, blowing agents, catalysts, and other additives prepared in the presence of hydroxyethyl acrylates in amounts as claimed by applicants (see column 2 lines 35-47, column 3 lines 46-65, column 6 lines 10-19, and example 6, as well as, the entire document).

As conceded by applicants' own specification, amine group containing compounds are groups which are inherently formed through natural weathering and aging of foamed polyurethane products resulting from the cleavage of urethane groups. Accordingly, the remaining hydroxyethyl acrylates residing in the structure of the polyurethane products of Smith would inherently react with the formed amines resulting from natural weathering and aging of the foamed products so as to form the products defined by claim 6. Thus, claim 6 is not seen to be distinguished from the teachings of Smith.

Applicants' arguments have been considered. However, rejection is maintained.

Smith is maintained to provide for presence of the compounds in the amount provided for by applicants' claims. Distinction of ranges of amount values based on intended use or function of the materials are not evident in distinguishing the claims as they stand. It is held and maintained that applicants have not shown difference in their products and/or processes based on differences in the compositional make-ups and/or processing operations as defined by the claims.

Smith provides a polyurethane composition containing compounds identified by applicants' claims in amounts meeting those of applicants' claims. It provides for its unsaturated functional groups to be available, like applicants' claims, for further reaction. Even after the first application of the foam forming material to a functionalized polyester surface, the foaming/foamed polyurethane has remaining functionality for an additionally applied unsaturated polyester resin, which is evidence that the

foaming/foamed composition contains unreacted unsaturated functionality before the additional polyester is applied in order to, thus, meet the claims of applicants' invention. Additionally, it would stand to reason that a meaningful portion of the unreacted unsaturated functionality would remain within the internal structure of the compositions of Smith, thus, still meeting the limitations of applicants' claims.

Smith's full teaching effect is not limited to what is disclosed by the examples. Its full teaching provides extensive overlap extending well beyond the lower endpoint of range of values of applicants' claims. While it is still seen that Smith's example 6 allows for amounts of compounds meeting the ranges of applicants' claims, examiner holds and maintains that its full teaching provides for inclusion of additive meeting applicants' claims far in excess of the amounts of hydroxyethyl acrylate included in Smith's exemplary embodiment.

It is held and maintained that Smith provides preparations of polyurethane foams containing unreacted unsaturated functionality to the degree claimed by applicants through the presence of compounds meeting those of applicants' claims and difference in the claims in the patentable sense has not been established

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Asako et al. (JP-06,336,513) & (5,668,187) patent documents, cited previously, are retained as art of interest for their disclosure of relevant compositions to the instant concern.

Art Unit: 1796

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Cooney whose telephone number is 571-272-1070. The examiner can normally be reached on M-F from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/John Cooney/

Primary Examiner, Art Unit 1796

**Application Number****Application/Control No.**

10/018,064

**Examiner**

John Cooney

**Applicant(s)/Patent under  
Reexamination**

ARLT ET AL.

**Art Unit**

1796